

PATENT

ATTORNEY DOCKET NO. 1999P07535US06 (1009-043)

SERIAL NO. 09/732,574

REMARKS

Reconsideration of this application is respectfully requested in light of the following remarks.

Each of claims 80 and 82 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 80, 82, and 84-93 are now pending in this application. Claims 80 and 82 are the independent claims.

I. The Anticipation Rejection

Claims 80, 82, 84-87, and 89-92 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Sexton (U.S. Patent No. 5,978,593) was cited. This rejection is respectfully traversed.

Sexton fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the

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prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. Jan. 6, 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

Filed herewith is a 37 CFR § 1.132 Declaration of Dr. Ronald D. Williams, a professor of engineering at the University of Virginia and one skilled in the art of electrical engineering. The information set forth in Dr. Ronald D. Williams' Declaration indicates that one skilled in the art would not find all of the elements and limitations of the claims in the recitations of Sexton.

Claims 80 and 82, from which claims 84-93 depend, recite "a **customized function call** adaptable to become a part of the operating system of said programmable logic controller". Paragraphs 11-14 of Dr. Williams' Declaration indicate that one skilled in the art would not find that Sexton teaches "a **customized function call** adaptable to become a part of the operating system of said programmable logic controller".

Accordingly, it is respectfully submitted that the rejection of claims 80 and 82 is unsupported by Sexton and should be withdrawn. Also, the rejection of claims 84-93, each ultimately depending from one of independent claims 80 or 82, is unsupported by Sexton and should be withdrawn.

II. The Obviousness Rejection

Claims 88 and 93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sexton (U.S. Patent No. 5,978,593). This rejection is respectfully traversed.

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Sexton does not establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP § 2143.

As discussed above, claims 80 and 82, from which claims 84-93 depend, recite "a **customized function call** adaptable to direct said programmable logic controller".

Consequently, Sexton does not teach or suggest all of the claim limitations, and thus does not establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejection is respectfully requested.

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CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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